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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,604	02/25/2002	Patrick W. Kelley	PWK-02-1	5706

7590
Thomas E. Kelley
P.O. Box 302
Mystic, CT 06355

10/22/2003

EXAMINER

EASHOO, MARK

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,604

Applicant(s)

KELLEY, PATRICK W.

Examiner

Mark Eashoo, Ph.D.

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 6-9, claim group II, in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the restriction requirement is not justified on the basis of serious burden on the Office and rather that a significant burden would be placed upon the inventor by a two-fold increase in fees. This is not found persuasive because:

1.) The claims were restricted between a product (eg. plastic log) and method of making. Applicant alleges that no serious burden would be placed upon the Office is severely mistaken. The examination of a product requires specific search and consideration of the structure of the product and does not depend upon how the structure was formed. Conversely, the process of making the product requires specific consideration of the stepwise limitations as the working material undergoes a physical or chemical change and little patentable weight is given to the structure of the formed product. Although some search areas may overlap the consideration given to a particular claim grouping is very different. Therefore, a serious burden, basically a two-fold increase in the search and consideration by the Office would be present if the restriction was not made.

2.) Applicant alleges that a significant burden of a two-fold increase in fees is placed upon the inventor. This is not persuasive because applicant has presented two distinct inventions, as set forth in the prior Office action, in a single application and would incur fees for only a single invention. Since the inventor is held to a single invention in this application, no added financial burden is placed upon the inventor.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lozach (US Pat. 4,049,760).

Regarding claim 6: Lozach teaches the basic claimed process of forming a plastic extrudate, comprising: extruding a plastic material through a die to form a mass with a molten surface (1:5-25 and Fig. 12); and cooling the molten surface of the extrudate with an air stream from a nozzle located proximate to the die (5:40-6:30 and Fig. 12, element A).

Lozach does not teach forming a cylindrical extrudate using a circular die. Lozach does teach that the extruded profile may be of "any shape" (1:1 and abstract). Nonetheless, forming cylindrical extrudates by using circular dies is well known in the extrusion art. At the time of invention a person having ordinary skill in the art would have found it obvious to have formed a cylindrical extrudate using a circular die, as commonly practiced in the art, in the process of Lozach, and would have been motivated to do so in order to provide a commonly stocked material shape for economic gain.

Regarding claim 7: Lozach further teaches further cooling of the extrudate by contact with an aqueous fluid (3:45-56).

Regarding claim 8: Since Lozach shows that the extrudate is exposed to ambient conditions while being supported (Fig. 12), it is inherent that the extrudate is cooled in part by natural air convection/convection.

Regarding claim 9: Lozach also teaches pulling the extrudate (3:56 and Fig. 12, element P).

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. March et al., Back, Wolstenholme et al., Wissinger et al., and Groeblicher all teach the basic state of the art.

Response to Arguments

Applicant's arguments filed in Paper No. 3 have been fully considered but they are not persuasive, because:

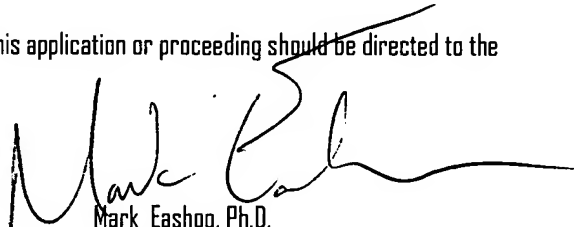
Applicant has amended product claims 1-5 to depend from process claim 6, thereby making claims 1-5 product-by-process claims. Since claims 1-5 are still subject to restriction and examination as a product (see MPEP § 2113).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (703) 308-3606. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaanni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

me
10/10/03

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